

REMARKS

Claims 9-15, 17 and 19-29 are pending the application; Claims 9-15, 17 and 19-29 stand rejected.

Claims 9-15, 17 and 25 are rejected under 35 USC 102(b) as allegedly anticipated by either Kuznicki or Mitsui. Applicant respectfully traverses, as neither Kuznicki nor Mitsui teach all of the elements of the claimed invention. Applicant further submits that *all* of the elements of the claimed invention have not been fully considered. A single prior art reference only anticipates a patent claim if it expressly or inherently describes ***each and every limitation*** set forth in the patent claim. Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The claim element excluded from analysis, in this case, by the Examiner, is "the therapeutic amount of the catechin selected for efficacy in treating amyloid, alpha-synuclein or NAC fibrillogenesis in a mammalian subject." Thus it is not just any composition containing a catechin that is being claimed but only compositions in which the therapeutic amount of the catechin has been selected for efficacy in treating amyloid, alpha-synuclein or NAC fibrillogenesis in a mammalian subject. Inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). As the cited references are completely silent with respect to therapeutic amounts of catechin selected for efficacy in treating amyloid, alpha-synuclein or NAC fibrillogenesis in a mammalian subject they are therefore NOT anticipatory. Reconsideration for the rejected claims is therefore requested, along with early favorable action on them.

Claims 9-24 and 26-29 are rejected under 35 USC 103(a) as allegedly obvious in view of Mitsui, and further in view of Kuznicki. Applicant respectfully traverses and submits that a *prima facie* case of obviousness has not been established, which is a requirement of section 2142 of MPEP. Specifically, the Examiner bears the burden of providing some suggestion of the desirability of doing what the inventor has done. In *Ex Parte Clapp*, 227 USPQ972, 973 (Bd.

Pat. App. & Inter. 1985) it is stated,

“To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references” (our emphasis).

In section 2143.01 of MPEP it states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir, 1990). The Examiner has combined Mitsui with Kuznicki and reasoned that the skilled person would be motivated to combine these teachings but has not presented any evidence to support the desirability or motivation for such a combination. Applicant submits that neither of the cited references expressly or implicitly suggest the claimed invention nor is there expressed a desire to combine with other references to arrive at the claimed invention. Applicant respectfully asserts that a *prima facie* case of obviousness has not been established and requests that the obviousness objections be withdrawn.

Applicant believes that it has responded fully to all of the concerns expressed by the Examiner in the Office Action, and respectfully requests reexamination of all rejected claims and early favorable action on them as well. If the Examiner has any further concerns, Applicant requests a call to Patrick Dwyer at (425) 823-0400.

Respectfully submitted,



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